

## REMARKS

This is intended as a full and complete response to the Final Office Action dated June 22, 2006, having a shortened statutory period for response set to expire on September 22, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-20 are pending in the application and remain pending following entry of this response.

### Claim Rejections - 35 U.S.C. § 103

Independent claims 1, 8, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fairchild et al.* (Patent No.: 6,728,760 81; Filing Date: May. 5, 1999) (hereinafter, "*Fairchild et al.*") in view of *Gupta et al.* (Pub. No.: US 2003/0196164 A1; Filed Sep. 15, 1999) (hereinafter, "*Gupta*").

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criterion.

For example, the references, even if combined as suggested in the Office Action, do not teach the claim limitation of "determining if the at least one annotation should be applied to the document, as changed, based on whether one of a set of one or more policies determining how annotations should be applied to different versions of the same document has been selected," as recited in independent claims 1, 13 and 17, or "determining if the annotation should be applied to the document as changed, by

determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document,” as recited in independent claim 8.

Applicants note that the Examiner concedes that Fairchild does not teach these limitations, but relies on Gupta as teaching these limitations. Applicants respectfully submit, however, that Gupta does not disclose any type of determination as to whether or not to propagate annotations to a document that has changed. In fact, Gupta teaches applying annotations to media streams that have the *same content* (albeit with different resolutions and/or compression ratios) of the same media stream, without any type of determination of whether or not the annotation should be applied. In short, Gupta is not concerned with documents, detecting changes to documents, or applying annotations to documents as changed based on policies.

Therefore, the references fail to teach or suggest all the claim limitations. Accordingly, independent claims 1, 8, 13 and 17 and their corresponding dependent claims are believed to be allowable, and allowance of the claims is respectfully requested.

### Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Randol W. Read, Reg. No. 43,876/  
Randol W. Read  
Registration No. 43,876  
PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicants